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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN CRAIG SEFTON, JEFFREY
JON JOHNSON, and GORDON SCOTT MINDRUM

Appeal 2016-007402
Application 13/416,258
Technology Center 2100

Before ROBERT E. NAPPI, CARL L. SILVERMAN, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) from a final rejection of claims 1–20, i.e., all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as Making Everlasting Memories, L.L.C. App. Br. 3.

STATEMENT OF THE CASE

The Invention

According to the Specification, the invention concerns “gathering and publishing information and content.” Spec. 3:9–10.² The Specification explains that a “publisher” is (1) “configured to receive a plurality of inputs such as audio, imagery, text, responses to questionnaires, and the like,” (2) “operable to access a registry having pre-existing information and content,” and (3) “operable to automatically generate a biographical text about a deceased friend or relative of the user, based on inputs and selections provided by the user.” Abstract.

Exemplary Claims

Independent claims 1 and 20 exemplify the subject matter of the claims under consideration and read as follows:

1. A method of producing a biographical writing, the method comprising:
 - (a) initiating a profiler to pose one or more questions to a user about a deceased person associated with the user;
 - (b) receiving one or more responses to the one or more questions from the user, wherein the one or more responses are about the deceased person associated with the user;
 - (c) selecting a plurality of template options to provide to the user, wherein the act of selecting template options comprises:
 - i. analyzing the one or more responses from the user about the deceased person associated with the

² This decision uses the following abbreviations: “Spec.” for the Specification, filed March 9, 2012; “Final Act.” for the Final Office Action, mailed January 28, 2015; “App. Br.” for the Appeal Brief, filed August 27, 2015; “Ans.” for the Examiner’s Answer, mailed May 26, 2016; and “Reply Br.” for the Reply Brief, filed July 25, 2016.

user to determine one or more personality traits of the deceased person associated with the user, and

ii. comparing the one or more personality traits of the deceased person associated with the user to one or more template options;

(d) providing the plurality of template options to the user;

(e) receiving a template selection from the user;

(f) requesting biographical information from the user, wherein the requested biographical information relates to the deceased person associated with the user, wherein the requested biographical information is usable as content for an automatically generated biography;

(g) receiving from the user the biographical information relating to the deceased person associated with the user; and

(h) automatically generating a biographical text using the template selection from the user with the content of the biographical information provided by the user relating to the deceased person associated with the user.

20. A method comprising:

(a) accessing a registry, wherein the registry comprises information relating to a plurality of subjects other than a user;

(b) receiving inputs, wherein at least a portion of the received inputs comprises information received from the registry pertaining to a select one of the plurality of subjects other than the user;

(c) initiating a profiler to pose questions to a user about the select one of the plurality of subjects other than the user;

(d) receiving responses to the questions from the user, wherein the responses are about the select one of the plurality of subjects other than the user;

(e) selecting a plurality of template options to provide to the user, wherein the act of selecting template options comprises:

i. analyzing the responses from the user about the select one of the plurality of subjects other than the user to determine one or more personality traits of the select one of the plurality of subjects other than the user, and

ii. comparing the one or more personality traits of the select one of the plurality of subjects other than the user to one or more template options;

(f) providing the plurality of template options to the user;

(g) receiving a template selection from the user; and

(h) automatically generating a writing using the template selection from the user with the received inputs.

App. Br. 44–45, 48–49 (Claims App.).

The Prior Art Supporting the Rejections on Appeal

As evidence of unpatentability, the Examiner relies on the following prior art:

Wood et al. ("Wood")	US 2002/0045154 A1	Apr. 18, 2002
Russell et al. ("Russell")	US 2002/0178079 A1	Nov. 28, 2002
Notargiacomo et al. ("Notargiacomo")	US 2003/0009461 A1	Jan. 9, 2003
Gatt	US 2005/0125725 A1	June 9, 2005
Bodin et al. ("Bodin")	US 2005/0154972 A1	July 14, 2005
Dorward et al. ("Dorward")	US 7,426,483 B1	Sept. 16, 2008

The Rejections on Appeal

Claims 1–5, 8–15, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Notargiacomo, Wood, Russell, and Gatt. Final Act. 3–28; Ans. 2–27.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Notargiacomo, Wood, Russell, Gatt, and Bodin. Final Act. 28–29; Ans. 27–28.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Notargiacomo, Wood, Russell, Gatt, and Dorward. Final Act. 29–30; Ans. 28–30.

Claims 16–19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Notargiacomo, Wood, and Russell. Final Act. 31–38; Ans. 30–37.

ANALYSIS

We have reviewed the rejections of claims 1–20 in light of Appellants’ arguments that the Examiner erred. For the reasons explained below, we disagree with Appellants’ assertions regarding error by the Examiner. We adopt the Examiner’s findings in the Final Office Action (Final Act. 3–38) and Answer (Ans. 2–68). We add the following to address and emphasize specific findings and arguments.

The Rejection of Claims 1–5, 8–15, and 20 Under 35 U.S.C. § 103(a)

INDEPENDENT CLAIM 1: LIMITATIONS
ALLEGEDLY MISSING FROM THE REFERENCES

Appellants argue that the Examiner erred in rejecting independent claim 1 because the references do not teach or suggest limitations (a), (b), (c)(i), and (c)(ii) concerning a “deceased person associated with the user.” App. Br. 17–21; Reply Br. 6–8. In particular, Appellants contend that

Russell “is directed to pets not people” and “makes no mention of a deceased person associated with a user.” App. Br. 17. In addition, Appellants contend that “[t]here is no mention whatsoever in Wood that any profiler, questions, responses, analysis for personality traits, etc. are directed to anyone other than the user themselves.” *Id.* at 19. Appellants also contend that “Wood teaches a system and method for targeting advertising and services to individuals based on their personality.” *Id.* at 20 (citing Wood ¶¶ 39–41).

According to Appellants:

[W]hat the Office has done here as seen on pages 5-7 of the Office Action is to omit the limitations of element (a) that require the questions posed by the profiler to be “about a deceased person associated with the user.” The Office continued by omitting the limitations of element (b) that require the one or more responses “are about the deceased person associated with the user.” With respect to element (c) the Office omitted the limitations that require the one or more personality traits are “of the deceased person associated with the user.” . . .

This approach amounts to the Office redrafting the claim limitation before conducting its obviousness analysis.

App. Br. 19.

Appellants’ contentions do not persuade us of Examiner error because, as the Examiner notes, the contentions address the references individually. Ans. 45. Where a rejection rests on a combination of references, an appellant cannot establish nonobviousness by attacking the references individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Moreover, “the test for combining references is not what the individual references themselves suggest but rather what the combination

of disclosures taken as a whole would suggest to one of ordinary skill in the art.” *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); *see In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Appellants do not address what the Notargiacomo-Wood-Russell-Gatt combination “taken as a whole would suggest to one of ordinary skill in the art” and, therefore, have not persuasively argued that the Examiner erred. App. Br. 17–21; Reply Br. 6–8.

The Examiner finds that Notargiacomo “teaches a method, system and computer software product for capturing and distributing memories of a deceased individual,” including a template for a website with an obituary. Ans. 45–46; *see, e.g.*, Notargiacomo ¶¶ 6, 9, 14, 19, 24, 28, 43–45, Abstract, Figs. 2a–2b. Notargiacomo explains that a data entry system at a funeral home “can be used for establishing and entering initial information regarding the deceased individual,” such as names of “the surviving family members” and “previously deceased family members.” Notargiacomo ¶¶ 44–45, Figs. 2a–2b. Further, the Examiner finds that Russell teaches methods for “conveniently conducting various transactions and business” relating to death, including a website that “enables users to post death notices and obituaries.” Ans. 47 (citing Russell ¶¶ 36, 46); *see, e.g.*, Russell ¶¶ 2, 36, 46, Title, Abstract; *see also* Ans. 41 (citing Russell ¶¶ 36, 40). In the Reply Brief, Appellants do not address those findings. Reply Br. 6–8.

In addition, the Examiner finds that: (1) Russell teaches a method where a user answers questions associated with a subject other than the user; (2) Wood teaches a method for determining “which question[s] to ask to a user in order to gather information” including personality information; and (3) Gatt teaches user selection from among a plurality of publication

templates. Ans. 41, 46–48 (citing Russell Abstract; Wood ¶¶ 36, 40, 75–77, 109–113; Gatt ¶¶ 55–58, Fig. 7A); *see* Final Act. 5–9.

The Examiner reasons that the Notargiacomo-Wood-Russell-Gatt combination teaches or suggests limitations (a), (b), (c)(i), and (c)(ii) in claim 1 because: (1) “Notargiacomo is receiving information about a deceased person”; (2) “Wood is determining the type of question[s]” to ask a user and analyzing the user’s answers “to obtain personality data”; (3) Russell discloses a website for death notices and obituaries for a subject other than the user; and (4) Gatt discloses template options. Ans. 47–49. We discern no error in the Examiner’s reasoning.

Appellants’ contentions that Russell “is directed to pets not people” and “makes no mention of a deceased person associated with a user” overlook Russell’s disclosure regarding the website MyEtribute.com relating to people not pets. *See, e.g.*, Russell ¶¶ 20, 24–34, 107–111, 115–229, Figs. 1–10; *see also* App. Br. 17. For instance, Russell explains that “MyEtribute.com combines, among other activities, tributes, messages, shopping, education and gathering of information into a single one-stop web site that offers a more convenient forum with which to conduct death related transactions.” Russell ¶ 107. Russell also explains that “MyEtribute.com provides a platform for mourners to learn about the death, respond to family wishes and access additional information.” *Id.* ¶ 110. As examples, Russell discusses “Susan, Coordinating Mourner for the Death of Her Mother, Elizabeth,” and “Deborah, Long-Distance Mourner of Former Asian-American Classmate, Anna.” *Id.* ¶¶ 115–180.

INDEPENDENT CLAIM 1: MOTIVATION TO COMBINE

Appellants argue that the Examiner erred in rejecting claim 1 because the motivation to combine the references provided by the Examiner “is insufficient” and “grounded solely in the use of hindsight bias.” App. Br. 12; *see* Reply Br. 3–6. Appellants assert that the Examiner “merely makes a conclusory and unsupported statement that the combination and modification would be obvious to one of ordinary skill because making the combination and modification allegedly satisfies the claim limitation in question.” App. Br. 13; *see* Reply Br. 3. Appellants also assert that the Examiner provides (1) “no explanation as to why or how the teachings of Wood can be combined with the teachings of Notargiacomo” and (2) “no cite to any reference” regarding “the motivation to combine and modify” Notargiacomo and Wood with Russell and Gatt. App. Br. 13–15. In addition, Appellants argue that the Examiner “believes that the motivation for combining the teachings of the art of record is sufficient merely because . . . the art of record is analogous.” Reply Br. 4.

Appellants’ arguments do not persuade us of Examiner error because (1) the Examiner finds that the motivation to combine comes from the references themselves and (2) the Examiner cites various portions of the references as support. *See, e.g.*, Final Act. 7–9 (citing Wood Abstract; Russell Abstract; Gatt ¶ 27); Ans. 7–9, 39–43 (citing Wood Abstract; Russell Abstract; Gatt ¶ 27). More specifically, the Examiner finds that one of ordinary skill in the art would have been motivated to combine Wood with Notargiacomo to improve Notargiacomo’s obituary website by adding the deceased person’s personality type and preferences based on Wood’s teaching concerning “determining personal characteristics of an individual

or group,” including “personality dimensions.” Final Act. 7 (citing Wood Abstract); Ans. 7, 40 (citing Wood Abstract); *see* Notargiacomo ¶¶ 44–45, Figs. 2a–2b; Wood Abstract. Based on Russell’s teaching, the Examiner finds that one of ordinary skill in the art would have been motivated to combine Russell with Notargiacomo and Wood to further improve the obituary website with information associated with a subject other than the user to provide a one-stop website for conducting various death-related transactions. Final Act. 8 (citing Russell Abstract); Ans. 8, 41–42 (citing Russell ¶ 36, Abstract); *see* Russell ¶ 36, Abstract. And based on Gatt’s teaching, the Examiner finds that one of ordinary skill in the art would have been motivated to combine Gatt with Notargiacomo, Wood, and Russell to further improve the obituary website with information compiled from a group of users. Final Act. 9 (citing Gatt ¶ 27); Ans. 9, 42–43 (citing Gatt ¶ 27); *see* Gatt ¶ 27.

Accordingly, the Examiner has articulated reasoning with a rational underpinning for why one of ordinary skill in the art at the time of invention would have combined Notargiacomo, Wood, Russell, and Gatt, including identifying advantages and improvements achieved with the combination. Final Act. 7–9; Ans. 7–9, 39–43. “[T]he law does not require that the references be combined for the reasons contemplated by the inventor.” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992). “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining” references. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). “[T]he desire to enhance commercial opportunities by improving a product or process is universal” *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1368

(Fed. Cir. 2006); *see In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003). “[A]n implicit motivation to combine” may result from a desire to make a product or process “stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient.” *DyStar*, 464 F.3d at 1368.

Appellants assert that “a person of ordinary skill in the art would only choose to combine” Wood with Notargiacomo “when guided by the hindsight granted by the claimed invention” because (1) “Notargiacomo does not discuss any weakness relating to the template it uses” and (2) Wood discloses a self-administered test for creating “promotional materials targeted at the user that self-administers.” Reply Br. 4. But the motivation to combine Wood with Notargiacomo rests on an advantage that Wood discloses instead of a weakness that Notargiacomo discusses. *See* Final Act. 7; Ans. 7, 40. In addition, Wood teaches broader use of personality data than just creating “promotional materials targeted at the user that self-administers,” such as obtaining “personality-based advice, content, and people-matching services” *See, e.g.,* Wood ¶ 42, Abstract; *see also* Reply Br. 4 (citing Wood ¶ 42); Wood ¶ 40 (describing “the delivery of personality based products and services”).

Appellants assert that “there is no apparent way to use Wood to determine a promotional material that is effective for marketing to persons associated with the person that is self-administering the test.” Reply Br. 5. That assertion misconstrues the rejection. The Examiner relies on Russell, not Wood, for teaching questions eliciting information about a subject other than the user. *See* Final Act. 8; Ans. 7–8, 41–42, 47–48. The Examiner relies on Wood for teaching questions eliciting personality information. *See* Final Act. 5–7; Ans. 4–7, 39–40, 46–47.

Appellants further assert that “[b]y introducing information from another entity, as described in Russell, the self-administered test and targeted promotional aspect of Wood is no longer functional” and “Wood is rendered unsatisfactory for its intended purposed.” Reply Br. 5. But “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference” *Keller*, 642 F.2d at 425. Instead, an obviousness analysis should consider “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Id.* Here, the combined teachings of Notargiacomo, Wood, and Russell would have suggested a website with an obituary about a deceased person other than the user that includes personality information about the deceased person. *See* Final Act. 3–8; Ans. 3–8, 39–42, 45–48. Combining Wood and Russell with Notargiacomo does not render Notargiacomo unsatisfactory for its intended purposed.

SUMMARY FOR INDEPENDENT CLAIM 1

For the reasons discussed above, Appellants’ arguments have not persuaded us that the Examiner erred in rejecting claim 1 for obviousness based on Notargiacomo, Wood, Russell, and Gatt. Hence, we sustain the rejection of claim 1.

DEPENDENT CLAIMS 2–5 AND 8–15

Appellants do not make any separate patentability arguments for dependent claims 2–5 and 8–15. App. Br. 21. Because Appellants do not argue the claims separately, we sustain the rejection of claims 2–5 and 8–15 for the same reasons as claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

INDEPENDENT CLAIM 20: LIMITATIONS
ALLEGEDLY MISSING FROM THE REFERENCES

Appellants argue that the Examiner erred in rejecting independent claim 20 because the references do not teach or suggest limitations (e)(i) and (e)(ii) concerning “one or more personality traits of . . . [a] subject[] other than the user.” App. Br. 28–31. More specifically, Appellants assert that the Examiner “only partially addresses these limitations . . . when discussing the Wood reference” and “fails to consider” the aspects of these limitations pertaining to the “one or more personality traits of the subject other than the user.” App. Br. 29. Appellants also assert that the Examiner “leaves the above aspects of elements (e)(i) and (e)(ii) of claim 20 directed to personality traits of subjects other than the user unaddressed by Russell or any of the combined art of record.” *Id.* Although Appellants advance additional arguments for claim 20, those additional arguments parallel Appellants’ arguments for claim 1. *Compare* App. Br. 29–31, *with id.* at 19–21.

Appellants’ arguments do not persuade us of Examiner error because, as the Examiner notes, the arguments address the references individually. Ans. 53. Appellants do not address what the Notargiacomo-Wood-Russell-Gatt combination “taken as a whole would suggest to one of ordinary skill in the art” and, therefore, have not persuasively argued that the Examiner erred. App. Br. 28–31.

The Examiner relies on Russell for teaching questions eliciting information about a subject other than the user and Wood for teaching questions eliciting personality information. *See* Final Act. 23–27; Ans. 23–26, 51–52, 54–56. In particular, Examiner finds that Russell teaches a

method where a user answers questions associated with a subject other than the user and Wood teaches a method for determining “which question[s] to ask to a user in order to gather information” including personality information. Ans. 51–52, 54–56 (citing Russell ¶¶ 36, 40, 46, Abstract; Wood ¶¶ 75–77, 109–113, 299, Abstract); *see* Final Act. 23–27. The Examiner further finds that “a pet associated with the user” as disclosed in Russell “may be considered a subject other than the user.” Ans. 56. Consequently, we discern no error in the Examiner’s finding that the combined teachings of the references satisfy limitations (e)(i) and (e)(ii) in claim 20.

INDEPENDENT CLAIM 20: MOTIVATION TO COMBINE

Appellants make essentially the same arguments regarding the motivation to combine Notargiacomo, Wood, Russell, and Gatt for claim 20 as for claim 1. *Compare* App. Br. 23–28, *with id.* at 12–17. For the reasons discussed for claim 1, Appellants’ arguments do not persuade us of Examiner error in combining Notargiacomo, Wood, Russell, and Gatt for claim 20.

SUMMARY FOR INDEPENDENT CLAIM 20

For the reasons discussed above, Appellants’ arguments have not persuaded us that the Examiner erred in rejecting claim 20 for obviousness based on Notargiacomo, Wood, Russell, and Gatt. Hence, we sustain the rejection of claim 20.

The Rejections of Claims 6 and 7 Under 35 U.S.C. § 103(a)

For the obviousness rejections of dependent claim 6 based on Notargiacomo, Wood, Russell, Gatt, and Bodin and dependent claim 7 based on Notargiacomo, Wood, Russell, Gatt, and Dorward, Appellants argue that

claims 6 and 7 “include all of the limitations of independent claim 1” and the arguments regarding claim 1 “apply equally” to claims 6 and 7. App. Br. 21. Appellants do not make any separate patentability arguments for claims 6 and 7. *Id.* Because Appellants do not argue the claims separately, we sustain the rejections of claims 6 and 7 for the same reasons as claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Rejection of Claims 16–19 Under 35 U.S.C. § 103(a)

INDEPENDENT CLAIM 16: LIMITATIONS
ALLEGEDLY MISSING FROM THE REFERENCES

Appellants argue that the Examiner erred in rejecting independent claim 16 because the references do not teach or suggest limitations (c), (d), (e)(i), (e)(ii), and (e)(iii) concerning a “deceased person associated with the user.” App. Br. 37–42; *see* Reply Br. 6–8. Appellants make essentially the same arguments regarding the limitations allegedly missing from the references for claim 16 as for claim 1. *Compare* App. Br. 37–42, *with id.* at 17–21; *see* Reply Br. 6–8. For the reasons discussed for claim 1, Appellants’ arguments do not persuade us of Examiner error in finding that the references teach or suggest limitations (c), (d), (e)(i), (e)(ii), and (e)(iii) in claim 16.

INDEPENDENT CLAIM 16: MOTIVATION TO COMBINE

Appellants make essentially the same arguments regarding the motivation to combine Notargiacomo, Wood, and Russell for claim 16 as for claim 1. *Compare* App. Br. 33–37, *with id.* at 12–15. For the reasons discussed for claim 1, Appellants’ arguments do not persuade us of Examiner error in combining Notargiacomo, Wood, and Russell for claim 16.

SUMMARY FOR INDEPENDENT CLAIM 16

For the reasons discussed above, Appellants' arguments have not persuaded us that the Examiner erred in rejecting claim 16 for obviousness based on Notargiacomo, Wood, and Russell. Hence, we sustain the rejection of claim 16.

DEPENDENT CLAIMS 17–19

Appellants do not make any separate patentability arguments for dependent claims 17–19. App. Br. 42. Because Appellants do not argue the claims separately, we sustain the rejection of claims 17–19 for the same reasons as claim 16. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner's decision to reject claims 1–20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED